



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,106	08/03/2001	Taizo Ogawa	6715/62367	2976

7590 12/05/2003

Jay H Maioli  
Cooper & Dunham  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/830,106

Applicant(s)

OGAWA ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/03/01 (Initial filing of application).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 14-18, 21-43, 46-49, 71-89 and 96-100 is/are rejected.
- 7) ☒ Claim(s) 10, 12, 13, 19, 20, 44, 45, 50-70 and 90-95 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers  
5 have been placed of record in the file.

### *Claim Objections*

2. Claims 49 and 88 are objected to because of the following informalities:

Re claim 49: the claim is dependent on itself. For treatment of the claim, the Examiner  
10 would understand it as being dependent on claim 48. Nevertheless, the Applicant is required to  
make correction.

Re claim 88, line 5: it appears that “o a connector” should have been “to a connector”.

Appropriation correction is required.

- 15 3. Examiner also notes the phrase “The recording ..... according to claim 1 wherein there  
is further provided an input unit .....”. Many claims are written in similar manner. Examiner  
respectfully suggests that the phrases may be rephrased as “The recording ..... according to  
claim 1 further comprising an input unit .....”. Although the Examiner could not find  
authoritative source for the words used in claim language, words such as “there” and “its” have  
20 not conventionally been used in claim language.

Applicant is respectfully suggested to review all claims presented and rephrase the  
occurrences of “where there is further provided” or similarly worded phrases.

4. Claim 17 is objected to because of the following informalities:

Re claim 17, lines 1-2: substitute "claim 16 wherein there is provided a further window" with --claim 16 further comprising a second window --. To differentiate the window recited in claim 17 and the window in claim 15, the Examiner strongly recommends the claim 15 to be rephrased using "a first window". Claim 15 should read "The recording and/or reproducing apparatus according to claim 1 further comprising a first window ....."

Appropriate correction is required.

10

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

15

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20

6. Claims 1-9, 11, 16, 17, 21-38, 41-43, 46, 47, 49, 71-81, 83, 85, 87-89, and 96-100 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohki et al. (US 6,016,957, "Ohki" hereinafter).

25

Re claims 1, 2, 16, 17, 21-25, 27, 42, 46, 71, 72, 78, 83, 85, 99, and 100, Ohki teaches a reading/writing (recording) apparatus 11 (see figure 2) and the methods for using the apparatus 11, comprising a main body portion of the apparatus on which a recording medium is removably loaded; a selection operation unit 114 provided toward one end from a mid portion of the main

Art Unit: 2876

body portion for selecting at least one operating mode; and loading/unloading unit 1104 for guiding the card into the apparatus and releasing the card after operation (col. 9, lines 55+). As shown in figure 1, the apparatus is comprised of an upper cover 116 and a lower portion 117 which encloses component parts of the reader, and a display unit 115/115' which display  
5 operational message or the results of transaction (col. 8, lines 63+). Ohki is silent on the size/dimension of the apparatus, however, considering the conventional size of the credit card or other cards, the apparatus is a portable device (see figures 1, and also figure 12), easily carried by the users.

Re claims 3, 28, and 73, the operation selection unit 114 is located on a surface of the  
10 main body portion opposite to the ejection unit – card insertion slot 111.

Re claims 4-6, 29-31, 74, and 75, although not explicitly detailed, loading/unloading unit 1104 moves the card to a position such that contact means of the card come in contact with the reader for I/O (col. 10, lines 21+). The insertion slot 111 is located towards the opposite side relative to a mid portion of the main body (see figures 2 and 3).

15 Re claims 7- 9, 11, 32-34, 36, 76, and 77, the keyboard 113/113' which is an input device can be removably mounted on the body of the apparatus as shown in figure 9 (col. 12, lines 51+). The detachably installed device obtains power from the reader via infrared or radio wave. Although Ohki does not explicitly suggests use of USB as an interface, as disclosed in figure 12, the terminal can be connected to other external devices such as personal computer (col. 13, lines  
20 66+).

Re claim 26, 49, 87-89, 93, 96-98, as the card is inserted and moved by the loading/unloading circuit 1104 to the position where I/O occurs, the card travels through many

Art Unit: 2876

positions on the transport path. Once situated, the connector 1105 connects the reader/terminal and the card (col. 9, line 55 – col. 10, line 20).

***Claim Rejections - 35 USC § 103***

5 7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various  
15 claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20 9. Claim 14, 39, and 82, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki et al. (US 6,016,957) in view of Abe et al. (US 6,015,954, “Abe” hereinafter). The teachings of Ohki have been discussed above.

Ohki fails to specifically teach or fairly suggest that the recording apparatus further  
25 comprises a lid mounted rotatably for opening and closing the medium insertion slot.

Abe teaches an IC card reader 10 comprising a cover member 40, which is rotatably mounted and closes the card insertion slot (see abstract; figures 1 and 2).

In view of Abe's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known lid/cover member to the teachings of Ohki in order to protect the card and the card reader from dust and other external debris. Lid or cover member is well known and widely used in the card reader for various purposes. Lids not only  
5 protects the card and the card reader, but functions as a positioning device, by pushing and keeping the card in the position where I/O can be performed. Moreover, by using the lid, external shock or unexpected jolt would not dislodge the card when the transaction is being performed, and therefore an obvious expedient.

10 10. Claims 15 18, 40, 48, 84, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki et al. (US 6,016,957) in view of Hoppe et al. (US 4,563,575, 6,015,954, "Hoppe" hereinafter). The teachings of Ohki have been discussed above.

Ohki fails to specifically teach or fairly suggest that the recording apparatus further comprises a window exposing inserted recording medium.

15 Hoppe teaches an IC card 1 and the IC reader 31 comprising a transparent window 33 (see figure 8) through which the inserted card is visible (col. 5, lines 24+).

In view of Hoppe's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further employ a transparent window to the teachings of Ohki so that one can readily see whether the card is in use. Such window not only provides quick  
20 means for the users to see if a card is loaded in the apparatus, but can be aesthetically pleasing. Additionally, as well known in the camera wherein the users can see the specification of the loaded film through slit window, the card users can be reminded of what cards are loaded in the apparatus (i.e., the reader is multi-purpose reader which reads magnetic, optical and IC cards).

***Allowable Subject Matter***

11. Claims 10, 12, 13, 19, 20, 44, 45, 50-70, and 90-95 are objected to as being dependent  
upon a rejected base claim, but would be allowable if rewritten in independent form including all  
5 of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: the  
claims are directed at a recording and/or reproducing apparatus and the recording medium used  
by the apparatus. As disclosed in used prior arts and other cited references, a portable terminal  
10 for an IC cards are well known in the art. However, the cited references, taken alone or in  
combinations, fail to suggest or teach a particular structure and the methods recited in these  
claims and the transparent window, which is applied with holographic features as recited in the  
claims.

***Conclusion***

15 I. The prior art made of record and not relied upon is considered pertinent to applicant's  
disclosure: Ruell (US 4,014,602); Obata et al. (US 5,960,208); Nott et al. (US 6,324,556);  
Toganazzini (US 5,850,077); Chan (US 6,254,001) disclose smart cards and reading/writing  
apparatus.

20 II. Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The  
examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru  
Friday.

25 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the  
Examiner is (703) 746-4782. The fax phone number for this Group is (703)872-9306.



Art Unit: 2876

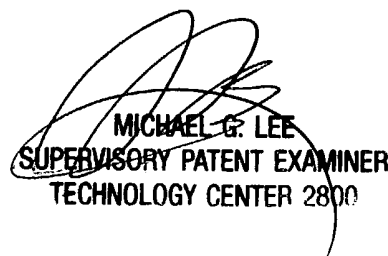
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim  
Patent Examiner  
Art Unit 2876  
November 19, 2003



MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800